

REMARKS

The claims have been amended to reduce the claims in number and to place the application in better form for Appeal.

More specifically, the limitations of claims 2, 3 and 4 have been added to claim 1, and claims 2, 3 and 4 have been cancelled.

Similarly the limitations of claims 14, 15 and 16 have been added to claim 13, and claims 14, 15 and 16 have been cancelled. The dependency of claims 5, 8, 9, 17 and 20 have been amended accordingly.

Claims 1 and 13 as amended now more clearly define applicant's unique sheet metal rod hanger, and the various embodiments are not shown or suggested by the applied disparate references of Havener and Kies.

Also submitted herewith is a Rule 132 Declaration of the inventor which makes of record digital photographic exhibits which show on the one hand a commercial form of the rod hanger as manufactured by ERICO®, and a complete (Chinese "or" at least Chinese manufactured) copy of the commercial form. A sample of the commercial form (**Exhibit J**) is also included for the Examiner's inspection. The two products are literally identical except for the trademark CADDY®, the UL® symbol, the part No. BC, and the slightly less reflective finish on applicant's.

The Declaration shows two indicia of unobviousness, which go hand in hand, i.e, commercial success and copying. Copiests don't copy failures.

It is also noted that the copiest didn't copy either the beam clamp Figure 10 of Havener, or the disparate slip-on nut of Kies.

With the claim amendments and the enclosed Rule 132 Declaration reconsideration of this application is respectfully requested.

In again rejecting all of Applicant's claims in shotgun fashion, the Examiner has combined concepts from normally unrelated arts.

There are literally scores of patents relating to slip-on nuts. Most of them involve carefully machined thread conforming moving parts. Push-on spring nuts date back to the second world war. The originally cited Tinnerman patent was filed in 1943. Such Tinnerman patent issued in 1944 and was cited against Kies. The art cited in Kies confirms this classification. It also confirms that no beam clamp such as Havener was ever cited against Kies.

Also, the Havener patent issued some thirty-eight years ago on an application filed forty years ago.

Havener shows one embodiment with a clearance hole 41 for a threaded rod 71 supported on top of the clamp by a conventional washer 72 with a conventional nut 73 providing vertical adjustability (Col. 3, lines 55-57). During a number of decades of coexistence, Havener didn't look to Tinnerman's art (Kies) nor has the slip-on-nut art looked to beam or purlin clamps or hangers.

That is until now. The Examiner seems to have no problem with this cross direction, but obviously only after reading and understanding applicants invention.

The Examiner has simply taken a concept from one art and applied it to another following Applicant's teaching. The fact that Havener doesn't begin to provide the plain side walls, or even sufficient space for two side wall slots to receive a clip and still grasp the threads, or the guides or back-ups necessary for a real world device, is of no concern, especially when only unrelated concepts are combined.

A leading oft cited authority on this subject is *In re Otiker* 24 USPQ 2nd 1443 (CAFC 1992), and at 446 the Court indicated:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ 2d 1315, 1318 (Fed. Cir. 1988); *In re Gieger*, 815 F.2d 686, 687, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil* 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985).

[5] Oetiker's invention is simple. Simplicity is not inimical to patentability. See *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 60 USPQ 386, 388 (1944) (simplicity of itself does not negative invention); *Panduit Corp. v. Dennison Mfg Co.*, 810 F.2d 1561, 1572, 1 USPQ 2d 1593, 1600 (Fed. Cir.) (the patent system is not foreclosed to those who make simple inventions), *cert. denied*, 481 U.S. 1052 (1987).

We conclude that the references on which the Board relied were improperly combined. Accordingly, the Board erred in holding the claims unpatentable under section 103. The rejection of claims 1-4 and 16-21 is

REVERSED.

This case obviously does not support the Examiner's position.

The Examiner, using only hindsight seems to be blazing a trail in relating the two different concepts, but could one skilled in the art accomplish the claimed invention without the blueprint of this application? For decades those skilled in the art did not. The answer is no.

The Examiners reference to the pipe or conduit bracket of Havener seen in Figures 7 and 8, and described in detail at column 3, lines 17-29, and turning it into an edge clip extension is simply a prime example of the hindsight reconstruction of the prior art following Applicant's blueprint.

Also in comparing Kies with the present invention, the two function differently. While Kies is a slip-on-nut, adapted to be placed on the threaded rod laterally, with the rod interfitting through the open part of the U-housing, no such open U-housing exists with the present invention. While the opposite side walls are provided with the parallel insert receiving slots, the other sides include the angled projections which back up and guide the tips of the legs of the insert from one set of slots to the other. These angled projections are recited in both claim 1 and claim 13. Also the tops and bottom of the housing preclude placing the rod laterally in the hanger or vice versa. The rod needs to be inserted axially and then retained by the clip insert, and if secured to a structure, final adjustments are obtained by rotating the rod. That isn't the way either Kies or Havener operates. This is perhaps best seen by examining the specimen **Exhibit J** enclosed with this Response.

You can of course rotate the entire clamp to adjust its position on the rod, but not after it has been secured or attached to a structure such as a beam or purlin edge, for example.

The claimed invention is a significant improvement over Havener, and Kies does not make it obvious.

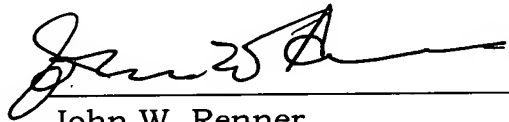
Applicants claims are submitted as patentable over the applied art as well as the other art of record, but not applied.

In view of the foregoing, this application is submitted as in condition for final allowance and early action to that effect is respectfully requested.

The amendment and the Rule 132 Declaration place the application in better form for Appeal and entry is requested.

Should any deficiencies or overpayments occur in the filing fees of the subject amendment, authorization is hereby given to charge Deposit Account Number 18-0988.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John W. Renner", is written over a horizontal line.

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